

REMARKS

Claims 1-4 and 7-13 are all the claims pending in the application. Claims 8 and 11 have been amended and new claims 14 and 15 have been added.

Claim Rejections - 35 USC § 112

Claims 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The narrower ranges of claims 8 and 11 has been removed by this Amendment and added as new claims 14 and 15, respectively.

Claim Rejections - 35 USC § 103

Claims 1-3, 7, 9-11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) U.S. Patent No. 5,419,283 to Leo in view of (2) U.S. Patent No. 6,178,922 to Denesuk and (3) U.S. Patent Pub. No. US 6,926,916 to Day et al. and (4) U.S. Patent No. 6,586,027 to Axelrod and (5) The Chestnut Comes out of its Shell, The New York Times (nytimes.com), by Melissa Clark, [retrieved from internet 12 December 2007] 24 November 1999, 3 pages. For the following reasons, Applicant respectfully traverses this rejection.

As far as the substantive objections are concerned, Applicant notes that in order to argue the obviousness of claims 1-3, 7, 9-11 and 13 - the Examiner had to combine the teachings of **five** (not three, as in the previous Office Actions) different references, by a "mosaicing" technique and with hindsight, which procedure is plainly improper. On the contrary, the combination of five different references (and even more against some further dependent claims) constitutes clear evidence of the unobviousness of the present invention, all the more in view of the fact that the presently claimed chew has the surprising effect of preventing the development

of salmonella in dogs consuming it (see page 3, third paragraph). No prior art document even remotely suggests that the chew with the presently claimed composition may have such an action, which thus supports the patentability thereof in view of the unexpected result achieved by the claimed invention.

Furthermore, the "Response to Arguments" chapter of the Office Action is defective such that the Examiner has failed to establish a *prima facie* case of obviousness.

The Examiner repeats indeed on page 10 that "Leo teaches the use of polyhydric alcohols (Leo col. 1, line 55-57)", so as this citation would render obvious the use of isomalt, which is a polyhydric alcohol. This argument is moot, since the Examiner did not correctly read the cited passage of Leo. It actually reads indeed "edible lubricants comprising mono-, di- and tri-esters of edible polyhydric alcohols with edible higher fatty acids". This passage thus teaches the use of esters, and not of polyhydric alcohols, such as isomalt, whose use is suggested solely for the formation of more complex chemical compounds. i.e. esters. Query whether the Examiner is in the position to assert that an ester is the same chemical compound as the alcohol by which it is obtained through reaction with an acid.

The considerations in respect of Axelrod on page 11 of the Office Action further confirm that the Examiner looked at the various references merely in order to pick up specific features therefrom, independently from the context in which they are mentioned. It goes without saying that such procedure is inadmissible, even in view of *In re Gorman*, 933 F.2d 982, 18USPQ2d 1885 (Fed. Cir. 1991), previously cited by the Examiner.

Axelrod teaches indeed the combination of starch and polymers and rawhide for forming a pet chew toy and, more specifically, both the abstract and col. 2, lines 19-26 of Axelrod are adamant in affirming that rawhide must be combined with denatured and partially hydrolyzed

collagen, which latter ingredient is absent in the presently claimed combination. On the contrary, it is fully unsupported asserting - as the Examiner does - that Axelrod teaches the use of raw hide per se in dog chews. No passage of Axelrod supports such an assertion, which thus has to be withdrawn.

Furthermore, Axelrod teaches that chestnut is used as an herbal addition to a pet chew and thus teaches away the use of "chestnut **flour**", as presently claimed, which is obtained from the fruit of chestnut and not the herbal portion thereof. Therefore, the Examiner cannot pick-up the alleged relevant teachings of Axelrod concerning the use of raw hide and discard the other teachings concerning the use of the herbal portion of the chestnut and not of "chestnut **flour**". In other words, the Examiner must either rely on the entire disclosure of Axelrod and conclude that the presently claimed feature "chestnut **flour**" would not have been obvious or discard all of the teachings of Axelrod and conclude that the presently claimed feature "rawhide" is not known.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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